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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,981	09/26/2001	Gero Baese	112740-300	3320

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EXAMINER

MA, JOHNNY

ART UNIT PAPER NUMBER

2623

DATE MAILED: 07/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/963,981		BAESE ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Johnny Ma		2623	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 February 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Priority***

1. Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d), a translation of the foreign applications should be submitted under 37 CFR 1.55 in reply to this action. However, for the purpose of expediting prosecution, the previous rejections under Koskelainen (EP 1113669A2), cited by Applicant, are withdrawn.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Youngs et al. (US 6,600,918 B1).

As to claim 1, note the Youngs et al. reference that teaches a method and system for providing transmission of selected media programs to a wireless subscriber.

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The claimed “radio transmitting the data” is met by MSC 22 coupled to transmitter towers 28 as illustrated in Figure 1 (Youngs).

The claimed “ which represents contents of a television program from a transmitter to a mobile radio terminal” is met by MSC 22 transmitting program content to a wireless handset 24 (Youngs 3:30-34) wherein the program content “can also be a pre-established media program, either prerecorded or live, such as television or radio broadcast” (Youngs 3:10-15).

As to claim 2, the claimed “wherein the transmitting step further comprises transmitting text data which represents contents of the television program” is met by the transmission of a list of available programs to the handset (Youngs 4:20-39).

As to claim 3, the claimed “wherein the transmitting step further comprises transmitting video data which represents contents of the television program” is met by the transmitting of television program content as discussed in the rejection of claim 1.

As to claim 4, the claimed “wherein the transmitting step further comprises transmitting video data which represents contents of the television program” is met by the transmitting of television program content as discussed in the rejection of claim 1.

As to claim 5, the claimed “further comprising the step of storing pre-selected television information in memory” is met by the transmission of a list of available programs from the MSC 22 to the handset 24 (Youngs 4:20-39) wherein it is inherent that the MSC 22 store the list of programs in memory in order for the list to be transmitted to the handset. The claimed “and wherein the transmitting step further comprises transmitting the stored pre-selected television program information” is met by the transmission of the list of available programs as discussed above.

As to claim 6, the claimed “wherein the transmitting step further comprises transmitting the stored pre-selected television program information by one of automatically, according to a predetermined schedule, on request, and combinations thereof” is met by the transmission of the list of available programs by automatically when the user enters a program request mode (Youngs 4:30-40).

As to claim 7, the claimed “further comprising the step of matching a form of the data to display options of the mobile radio terminal” is met by “[t]here may be some instances in which the wireless handset 24 can only receive a portion of the media program, such as the audio portion of an audio/video television transmission. In this case, the MSC 22 would only transmit the audio portion for transmission to the wireless handset 24” (Youngs 3:24-30).

As to claim 8, the claimed “further comprising the step of automatically billing costs for the transmission via a telephone bill for the user of the mobile radio terminal” is met by “MSC 22...compiles mobile billing information” (Youngs 2:26-30).

As to claim 9, the claimed “wherein the data which represents contents of a television program represents only a portion of the television program, and wherein the transmitting step further comprises transmitting the data which represents only a portion of the television program from the transmitter to the mobile radio terminal” is met by “[t]here may be some instances in which the wireless handset 24 can only receive a portion of the media program, such as the audio portion of an audio/video television transmission. In this case, the MSC 22 would only transmit the audio portion for transmission to the wireless handset 24” (Youngs 3:24-30).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 10-14 rejected under 35 U.S.C. 103(a) as being unpatentable over Wegener et al. (US 6,490,432 B1) in further view of Youngs et al. (US 6,600,918).

As to claim 10, note the Wegener et al. reference that teaches a distributed media on-demand information service. The claimed “a [...] program memory device capable of storing the [...] program” and “a data memory device having the data which at least partially represents contents of the [...] program” is met by “[s]ervice provider 8 provides audio and/or video content to remote content database 10 that is stored in, for example semiconductor memory, rotating media, or other permanent form...Content database 10 as shown in FIG. 1 is illustrative, and may be several remotely located data sources that store content for access” (Wegener 5:15-28) wherein among the plurality of data sources that store content, a first data source satisfies the claimed program memory device and a second data source satisfies the claimed data memory device. Note the Wegener et al. reference teaches the use of audio and/or video content and broadcast content portions comprising programs (Wegener 5:15-16; 5:35-38). However, the Wegener et al. reference does not specifically teach that the programs comprise television programs. Now note the Youngs et al. reference that teaches a method and system for providing transmission of selected media programs to a wireless subscriber wherein “[t]he media program providers 32 can provide any kind of media including, but not limited to, audio, video, and data.

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The communication can also be a pre-established media program, either prerecorded or live, such as a television or radio broadcast” (Youngs 3:10-15). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Wegener et al. programming with the Youngs et al. programming including television programming for the purpose of providing a widely disseminated media type and increasing the availability of programs to a user. Note the Wegener et al. and Youngs et al. combination, as discussed above, teaches the claimed television program memory device and data memory device. The claimed “a transmitter device connected to the television program memory device and the data memory device” is met by content database 10 (comprising television program memory device and the data memory device) connected to two-way communication towers 34a or 34b as illustrated in Figure 2 (Wegener). The claimed “the transmitter device transmitting the data via a mobile radio network to the mobile radio terminal” is met by the radio transmission of programming to a mobile device (Wegener 5:18-23; 6:49-61).

As to claim 11, please see the rejection of claim 10 as discussed above.

As to claim 12, the claimed “wherein the device having a television program further comprises one of a device having a live television program, a memory which stores a recorded television program, and combinations thereof” is met by the Wegener and Youngs combination as discussed in the rejection of claim 10 wherein programming includes prerecorded or live television programs.

As to claim 13, the claimed “wherein the device having data which at least partially represents contents of the television program further comprises one of a device having on-line generated data, a memory which stores the data, and combinations thereof” is met by the

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Wegener and Youngs combination as discussed in the rejection of claim 10 wherein content database 10 stores the data.

As to claim 14, the claimed “wherein the device having data which at least partially represents contents of the television program further comprises one of a device having on-line generated data, a memory which stores the data, and combinations thereof” is met by the Wegener and Youngs combination as discussed in the rejection of claim 10 wherein content database 10 stores the data.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The Bonomi et al. reference (US 6,769,127 B1) teaches a method and system for delivering media services and application over networks.

The Eaton et al. reference (US 6,765,474 B2) teaches a method and apparatus for providing additional information to a selective call device about a broadcast.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johnny Ma whose telephone number is (571) 272-7351. The examiner can normally be reached on 8:00 am - 5:00 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

jm

  
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